

### REMARKS

In the Final Office Action mailed July 28, 2005, the Examiner rejected claims 1, 3-18, 20 and 21. Applicants reassert all previous arguments made in previous responses relative to the claims of the present application. Applicants also address the assertions made in the Final Office Action and request that reconsideration be given to the claims of the present application.

In the case of In re Rouffet (CA FC) 47 USPQ2d 1453, 1457-1458 (July 1998), the court wrote:

Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. Section 103(a). This legal construct is akin to the "reasonable person" used as a reference in negligence determinations. The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. See *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ2d 1207, 1211 (Fed. Cir. 1993).

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Applicants contend that the most recent Office Action has, like its predecessors, ignored the framework for determining obviousness as set out by the CAFC. Since the actual rejections of the most recent Office Action have already been addressed, Applicants address only the Response to Arguments section of the Office Action and incorporate all previous arguments by reference.

In the Response to Arguments section at pages 15-18, an attempt is made to suggest that “shortening of production time” is a sufficient motivation to suggest the use of an adhesive having an elongation of 300%. The Office Action cites precedence in support of the asserted motivation, however, the precedence does not apply to the claims of the present application. The Office Action also tries to assert another reference to bolster the asserted motivation, however, that reference does not even suggest an adhesive having an elongation of 300%.

As support for the motivation provided, the Office Action cites Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) as suggesting that the, “fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art...cannot be the basis for patentability when the differences would otherwise be obvious.” However, Applicants still contend that the prior art does not suggest the use of an adhesive having elongation of at least 300% for a roof module as recited in the claims of the present application. Moreover, the Office Action suggests that shorter “working times” of an adhesive of an entirely different patent (U.S. 5,976,305) support the motivation of “shortening of production time”. However, these “working times” provide no motivation for the use of an adhesive having an elongation of at least 300%. Furthermore, Ex parte Obiaya is not an appropriate precedence. Obiaya, at best, suggests that recognition of a second advantage of one particular combination is not sufficient to impart patentability in a situation where a first advantage already suggests the combination. However, the adhesives having shorter “working times” may or may not have at least 300% elongation and vice versa. One property does not necessitate the other even if both potential properties are disclosed in one reference. Applicants contend that the motivation provided by the Office Action must actually suggest the specific claimed

combination to be legally sufficient and the asserted motivation does not suggest the combination.

The Office Action also attempts to bolster its claim of obviousness with the following quote from Lumpe et al. (US Patent 6,592,176):

The modular roof of the present invention, the roof rails are preferably fastened on the roof module via a fastening system comprised of gluing, soldering, welding, screwing or riveting. This has the advantage of eliminating the expense associated with designs for balancing tolerances between a roof panel and a recess with the vehicle roof.

While this quote, at best, generally suggests the possibility of using glue with a roof module, it does not suggest adhesion of the bottom edge of a transparent panel or windshield to a body of a vehicle. Moreover, it does not suggest the use of an adhesive having elongation of 300%.

In the Response to Arguments section at page 17, the Office Action suggests that the advantages discussed by Applicants in relation to the provision of a roof panel with a windshield between A-pillars being attached to B and/or C-Pillar that are part of the body of the vehicle are immaterial. The Office Action again cites Obiaya for the proposition that “the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability...” This citation of precedence is again misguided. Applicants brought these advantages forward to further show the novelty and non-obviousness of the claims 9, 17 and 18 of the present application. In particular, the advantages being discussed are new because of the new method of assembling a roof module that is provided by claims 9, 17 and 18 and neither the methodology or advantages thereof are disclosed or suggested by the prior art.

The Office Action, at page 17, also suggests that, “...Applicant’s roof panel too does not include any pillar therefore the argument that the Lumpe et al. is not a proper reference because the roof module of Lumpe et al. does not include any pillars is moot.” Claim 9, similar to claim 17 and 18, reads as follows:

providing the roof module wherein the roof module includes:

- a) a roof portion having a forward edge, a rearward edge, a pair of side edges and a pair of A-pillars extending from adjacent opposing corners of the roof portion...

Applicants contend that the assertion of the Office Action is false.

In view of the above, Applicants maintain that obviousness has not been established against the claims of the present application and that all rejections should be withdrawn.

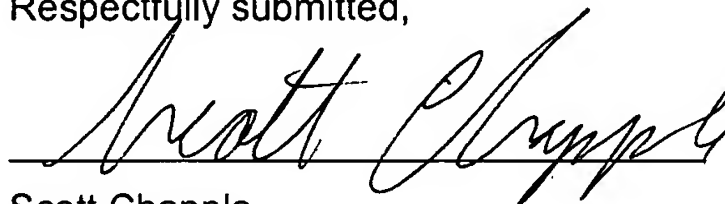
### CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 04-1512 for any fee which may be due.

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Respectfully submitted,



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